

REMARKS

Applicants have carefully reviewed the Application in light of the Office Action mailed October 3, 2003. Claims 1, 2, 4-14, 16-26, 28-32 and 34-38 remain pending in the Application and stand rejected. Applicants add new Claims 40-42, which are fully supported by the specification as originally filed.

Section 103 Rejections

The Examiner rejects Claims 1, 2, 4-14, 16-26, 28-32, and 34-38 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,039,244 to Finsterwald ("*Finsterwald*") in view of U.S. Patent No. 6,450,407 to Freeman, et al. ("*Freeman*"). Applicants respectfully traverse these rejections.

The Finsterwald-Freeman combination fails to teach or suggest all elements.

Applicants respectfully submit that the *Finsterwald-Freeman* combination fails to teach or suggest all elements of Claims 1, 2, 4-14, 16-26, 28-32, and 34-38. Consider Applicants' Claim 8, which recites:

8. An apparatus for rebate processing, comprising:
 - a first memory operable to store promotion information describing a plurality of promotions, the promotion information comprising, for each of the promotions, a promotion sponsor identifier, a promotion identifier, promotion requirements, and at least one disbursement option;
 - a second memory operable to store transaction information indicating a plurality of product purchases, the transaction information comprising, for each of the purchases, a consumer identifier, a rebate request status, and a promotion identifier matching to a selected one of the promotions; and
 - a processor operable to process rebate requests by associating the product purchases with the promotions using the promotion identifiers and determining whether selected transaction information for the purchases satisfies the rebate requirements for the promotions, the processor further operable to provide rebate status updates to the consumers using the rebate request statuses and to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.

Applicants respectfully submit that *Finsterwald* and *Freeman*, taken alone or in combination, fail to teach or suggest all elements of this claim. For example, Claim 8 includes:

a processor operable to process rebate requests by associating the purchases with the promotions using the promotion identifiers and determining whether selected transaction information for the purchases satisfies the rebate requirements for the promotions, the processor further operable to provide rebate status updates to the consumers using the rebate request statuses and to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.

None of the cited references teach or suggest this element and its operation. *Finsterwald*, in general, teaches techniques for generating unique codes and associating each code with a particular product or purchase. See, e.g., *Finsterwald*, at column 1, lines 41-65. A consumer, having received a unique code at purchase, can then submit the code to receive “points” that may later be redeemed for other products or services. *Finsterwald*, at column 2, lines 19-33. These points may be stored in an account created for the consumer. *Finsterwald*, at column 9, lines 16-25.

In rejecting the claims, the Examiner addresses selected claimed aspects by reference to the point account of *Finsterwald*. For example, the processor element of Applicants’ Claim 8 is “operable to provide rebate status updates to the consumers using the rebate request statuses.” As teaching for this aspect, the Examiner cites to column 10, lines 21-25 of *Finsterwald*. This portion of *Finsterwald* explains that a consumer can access his “point account” to determine how many points have been accumulated. However, *Finsterwald* teaches that these points are credited immediately upon receiving a valid code. *Finsterwald*, at column 9, lines 41-44. Thus *Finsterwald* does not disclose any rebate request transaction that remains pending such that status updates would be appropriate. Moreover, *Finsterwald*’s disclosure of a point account balance simply does not teach the processor “operable to provide rebate status updates to the consumers using the rebate request statuses.”

Additionally, the Examiner admits that *Finsterwald* fails to disclose the claimed aspects of generating promotion reports for sponsors. As teaching for these aspects, the Examiner cites to *Freeman*, at column 11, lines 16-20, which recites:

Records of electronic money rebate payments to users may be maintained in a database for a time period for the purpose of permitting audits of the payment data by the manufacturers or other party that is paying for the rebates.

However, simply maintaining payment records for potential audits does not show the processor of Claim 8, operable “to generate promotion reports, a promotion report comprising selected promotion information for at least one of the promotions having a particular promotion sponsor identifier.”

This deficiency of *Freeman* is highlighted even more dramatically in the Examiner’s attempt to show the elements of dependent Claim 13, which recites:

13. The apparatus of Claim 8, further comprising an interface operable to communicate one of the promotion reports to a promotion sponsor, the communicated promotion report comprising a number of rebate requests and a breakage rate for each promotion associated with the promotion sponsor.

In addressing this claim, the Examiner states:

Freeman further discloses the promotion reports includes [sic] all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses or requestors, etc. (col 11, lines 16-29).

Office Action, at page 4 (underline in original). However, an examination of the cited language reveals no mention of “pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses or requestors, etc.” *Freeman*’s disclosure of payment records and associated reconciliation efforts simply does not teach promotion reports as claimed in Claims 8 or 13.

Independent claims 1 and 20 include limitations that, for substantially the same reasons as discussed with respect to Claim 8, are not shown by the cited references. The claims depending from these independent claims add further patentable limitations. In addition, Applicants note that independent Claim 32 recites an interface for facilitating rebate processing that includes a number of limitations not addressed by the Examiner and not shown in the cited references. Thus for at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection to the claims based upon the *Finsterwald-Freeman* combination.

The combination of Finsterwald and Freeman is improper.

In addition, Applicants respectfully submit that the combination of *Finsterwald* and *Freeman* is improper. As noted above, the cited portions of *Freeman* deal with maintaining

payment records for potential audits. In contrast, *Finsterwald* discloses a point collecting system that does not contemplate making payments to consumers. Thus *Finsterwald* has no need for payment record-keeping and does not contemplate combination with a payment record-keeping reference.

Moreover the Examiner's statements regarding motivation focus on potential advantages of Applicants' claims to explain motivation for the combination. The Examiner states:

One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Office Action, at page 3 (sic) (underline in original). However, as previously noted, the cited portions of *Freeman* deal with maintaining payment records for potential audits. The Examiner fails to show how maintaining these audit records can "enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better." Thus while the Examiner does cite to a potential advantage of Applicants' claimed invention, the Examiner fails to show how the cited references provide this advantage. Moreover, Applicants respectfully submit that the proposed reasons for the combination simply represent impermissible hindsight reconstruction. For at least these reasons, Applicants submit that the proposed combination is not proper. Therefore, Applicants respectfully request that the Examiner withdraw the rejection to the claims based upon the *Finsterwald-Freeman* combination.

New Claims

Applicants adds new Claim 40-46, which are fully supported by the specification as originally filed. The new claims recite elements that make these claims allowable over the cited references. Accordingly, Applicants respectfully request consideration and allowance of new Claims 40-46.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

An additional filing fee of \$104.00 is due. The Commissioner is hereby authorized to charge the \$104.00 fee, and any additional fees, or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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